



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/814,159	03/20/2001	John Rodriguez	LS/0011.00	2460

7590 12/10/2003

John A. Smart
708 Blossom Hill Rd., # 201
Los Gatos, CA 95032-3503

EXAMINER

ZURITA, JAMES H

ART UNIT	PAPER NUMBER
----------	--------------

3625

DATE MAILED: 12/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/814,159

Applicant(s)

RODRIGUEZ ET AL.

Examiner

James H Zurita

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other: _____

DETAILED ACTION

Priority

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification of in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5, 7-17, 19-26, 28-40 are rejected under 35 U.S.C. 101 because the claims have no connection to the technological arts and are directed to non-statutory subject matter. While the term *data element* may be used to infer that the information is being provided using some type of electronic communication medium, the information could also be provided using a vocal medium (i.e. spoken) or index cards (i.e. written) and is, therefore, directed to non-statutory subject matter.

The invention as recited in the claims is merely an abstract idea that is not within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use or advance the technological arts fail to promote the “progress of science and the useful arts” (i.e., the physical sciences as

opposed to social sciences, for example) and therefore are found to be non-statutory matter. The mere recitation in the preamble or mere suggestion in the claim that a machine is performing some or all of the steps in the method is not enough to place the claimed invention in the technological arts. The body of the claims must unambiguously recite that a machine/apparatus is performing the step(s) and/or integrally involved in the process.

To overcome this rejection, the Examiner recommends that the Applicant amend the claim to clarify that the methods are using a medium within the technological arts, such as replacing "data element" with "an electronic data element" or a specific medium such as the Internet, computer network, etc.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al., (US 5,892,900).

Ginter discloses methods and systems for managing and tracking transactions involving media assets on a network such as the Internet. The network may be serviced by one or more service providers, including Internet service providers. Ginter discloses:

tracking information...uploaded by various types of authors and owners and other content providers.

receiving a request from user(s) ...to obtain uniquely identified digital content

tracking transaction information ...including auditing and metrics for each uniquely identified item

generating reports...including usage, metrics and billing information.

Ginter discloses that assets may include images, audio, video and text-based media (see, for example, Col. 31 line 26-Col. 32 line 60). Ginter discloses various types of service providers, including internet service providers, content providers, financial providers and others. See, for example, Col. 46 line 1-67Col. 47 line 20. Ginter discloses Billing, Revenue tracking. See for example, Col. 313 line 8-Col. 315 line 41.

Ginter discloses various types of reports, including usage reports, usage auditing, usage reporting. See, for example, Col. 340, line 35-Col. 344, line 54.

Ginter discusses electronic content providers that may include various types of e-commerce entities, including providers of commercially distributed content, electronic currency, business transactions such as EDI.

Ginter **des not** specifically disclose that the system and methods steps

“...characterize a particular media asset of interest that is uploaded to the network”;

“...engage one or more of said service providers to perform one or more services for the particular media asset”;

“...allows billing of the requested services, including tracking information, including tracking information indicating which service providers performed a service for the particular media asset”;

“...indicate a provider's billing information in connection with providing services for the various media assets present on the network”

However, after reviewing each claim as a whole, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The steps of tracking information, receiving a request from user(s), tracking transaction information and generating reports would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to

“...characterize a particular media asset of interest that is uploaded to the network”;

“...engage one or more of said service providers to perform one or more services for the particular media asset”;

“...allows billing of the requested services, including tracking information indicating which service providers performed a service for the particular media asset”;

“...indicate a provider's billing information in connection with providing services for the various media assets present on the network”

because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

As to the system claimed by applicant, Ginter **does not** specifically disclose that functions are performed by particular modules, recited in the claimed invention, such as a module for receiving content from authors
a module for processing a request from a user
transaction modules for tracking transaction information
report generation module.

However, the specific meaning/interpretation of the actions of the one or more modules loaded onto a processor does not patentably distinguish the claimed system. Further, the recited statement of intended uses, including

...uploading of a particular media asset of interest that is uploaded to the network;
...processing a request from a user to engage one or more of said service providers to perform one or more services for the particular media asset;
...tracking transaction information pertaining to billing of the requested services, including tracking information indicating which service providers performed a service for the particular media asset, including posting credits and/or debits to accounts of the service providers that were engaged; and a

...for indicating a provider's billing information in connection with providing services for the various media assets present on the network does not patentably distinguish the claimed system. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide any type of modules in the system taught by Ginter because the subjective interpretation of the functions performed by particular modules does not patentably distinguish the claimed invention.

Ginter does not specifically disclose that the system may include service providers that provide photofinishing services (as in claims 5 and 26). It is well known that some service providers provide services such as finishing photos, perhaps by developing film, printing images, translating stored images from one format to another and providing the images online. For example, numerous services provide photo development and uploading, image processing and distribution of the images over the Internet.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include photofinishing service providers among the various types of service providers found in Ginter. One of ordinary skill in the art at the time the invention was made would have been motivated to include photofinishing service providers among the various types of service providers found in Ginter for the obvious reason that an author may wish to make his family's images available to other members of his family, perhaps living in far away countries. In such a case, family members may

Art Unit: 3625

obtain photofinishing services from the service provider, and such access would be monitored by Ginter's system.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Zurita whose telephone number is 703-605-4966. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynne Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-1113.

JZ
James Zurita
Patent Examiner
Art Unit 3625
26 November 2003


Jeffrey A. Smith
Primary Examiner